

### **REMARKS**

In reply to the Notice of Non-Compliant Amendment mailed on January 4, 2007, Applicant has changed the characterization of Claim 16 to “currently amended.” Claim 18 is currently amended to provide antecedent basis for “non-telescopic gun sight”, and appears to be in condition for allowance. Claim 23 has been amended to independent form including all the limitations of the base claim 19 and intervening claim 22, and appears to be in condition for allowance. No new matter has been added. Please charge any required fees or credit overpayment to Deposit Account 502931.

### **SUMMARY OF PREVIOUSLY SUMMARIZED EXAMINER INTERVIEWS**

As discussed in the previous response, a telephone interview was held between Examiner Johnson and Applicant’s Attorney Theodore C. McCullough on July 14, 2006. Certain amendments to claim 1, and the relevance, as prior art, of The *King* patent (U.S. Pat. No. 2,056,469, **which was discovered by the Examiner** and brought to the attention of Applicant’s Attorney by the Examiner) were discussed. Additionally, Examiner Johnson agreed to review the currently amended claim set vis-à-vis the *King* patent for purposes of 35 USC § 103(a) and, if such is required, suggest patentable claim language in the next response. Since the *King* reference was first brought up by the Examiner, the Examiner should cite it as having been considered.

**Examiner Johnson also agreed during the interview to cite the *King* patent (U.S. Pat. No. 2,056,469) in his next office action, and Applicant again respectfully requests that an initialed form SB08 with the *King* patent be provided by the Examiner.**

### ***Previously withdrawn claims***

As Applicant noted in the prior response, claims 6-9 were previously withdrawn due to a restriction requirement. The Examiner has now **allowed claim 1**. Since these previously withdrawn claims 6-9 depend from claim 1 (which has been allowed), these claims appear in

condition for allowance. Applicant requests that these claims be reconsidered and be removed from withdrawn status, and an early indication of allowance is respectfully requested.

***Claim Rejections – 35 U.S.C. § 112 paragraph 2***

Claim 18 was rejected under 35 U.S.C. § 112 paragraph 2 as being indefinite. Claim 18 has been amended to avoid indefiniteness. Accordingly, reconsideration of the rejection and allowance of these claims is respectfully requested.

***Claim Rejections – 35 USC § 102(b)***

Claims 19-22, and 26 were rejected under 35 USC § 102(b) as being anticipated by *Hasselbusch* (United States Pat. No. **4,837,937**), *Jacobson* (United States Pat. No. **2,671,966**), and *Finch* (United States Pat. No. **4,875,290**). Applicant respectfully traverses. First, claims 19-22, and 26 are means-plus-function claims that must be examined according to 35 U.S.C. 112, sixth paragraph. Second, all three references compensate for windage and not for target motion. One basic difference is that the windage compensation described in the references only works for targets that are fixed to the ground such that the target (e.g., deer or haybales) is not moved by the wind but the projectile (bullet or arrow) is pushed to the side by the wind. There is no need for windage compensation for flying targets since the target is pushed to the same side in the same manner as the projectile, and for the same amount of time as the projectile, and no lead angle is needed.

**MPEP 2106 Requirements in interpreting means-plus-function claims:**

“Where means plus function language is used to define the characteristics of a machine or manufacture invention, claim limitations **must be interpreted to read on only the structures or materials disclosed in the specification and “equivalents thereof.”** (Two en banc decisions of the Federal Circuit have made clear that the Office is to interpret means plus function language according to 35 U.S.C. 112, sixth paragraph. In the first, *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the court held:

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate,

and there is no legislative history indicating that Congress intended that the PTO should be. Thus, this court must accept the plain and precise language of paragraph six.

Consistent with *Donaldson*, in the second decision, *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (in banc), the Federal Circuit held:

Given Alappat's disclosure, it was error for the Board majority to interpret each of the means clauses in claim 15 so broadly as to "read on any and every means for performing the function" recited, as it said it was doing, and then to conclude that claim 15 is nothing more than a process claim wherein each means clause represents a step in that process. Contrary to suggestions by the Commissioner, this court's precedents do not support the Board's view that the particular apparatus claims at issue in this case may be viewed as nothing more than process claims.

Disclosure may be express, implicit or inherent. Thus, at the outset, Office personnel must attempt to correlate claimed means to elements set forth in the written description. The written description includes the original specification and the drawings. Office personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See *Kemco Sales, Inc. v. Control Papers Company, Inc.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Further guidance in interpreting the scope of equivalents is provided in MPEP § 2181 through § 2186.

While it is appropriate to use the specification to determine what applicant intends a term to mean, a positive limitation from the specification cannot be read into a claim that does not impose that limitation. A broad interpretation of a claim by Office personnel will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified or intended. An applicant can always amend a claim during prosecution to better reflect the intended scope of the claim.

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. ...").

## ANALYSIS

With respect to claims 19-22 and 26, the Final Office Action failed to provide the required § 112-6 analysis showing equivalent structures. With regard to claim 19's "means on the gun sight for sighting a target through a substantially enclosed outline to allow positioning of the gun barrel to compensate for a distance to the target and for a motion of the target," Applicant respectfully submits that *Hasselbusch 937* lacks any structure "for sighting a target through a

substantially enclosed outline,” but rather shows and describes an open-top U-form groove 8 extending front-to-back of the sight 1 (groove 8 is left-right in the top/plan view of Figure 1, is not visible in the right-side elevation view of Figure 2, is seen with side walls 9 and 11, shoulder 12, and screw 13 having notch 15 in Figure 3, and is seen in Figure 4 as clearly not enclosed with side walls 9 and 11 as the sides), shoulder 12 between wall 9 and wall 11, and notched screw 13 defining the bottom of the groove. The Examiner is mistaken in asserting notch 15 is enclosed.

Further, wind compensation by *Hasselbusch* is accomplished by a constant side-side compensation angle, regardless of distance, and distance compensation is only for bullet drop, not for target motion. *Hasselbusch* mentions target motion only in the context of having to aim and fire quickly, in which case the user cannot make screw-sighting adjustments, and thus uses the side walls 9 or 11 to compensate for wind (no compensation for target motion is described or suggested by *Hasselbusch*) or use shoulders 12 or 23 for bullet-drop-over-distance compensation. In contrast, the structures of the present invention provide a plurality of substantially enclosed sights at different target-motion compensation angles. Since the Final Office Action has failed to point out any equivalent structures to those accomplishing the recited functions, claim 19 and its dependent claims 20-22 appear in condition for allowance. Further regarding claim 20, the Final Office Action has failed to point out any equivalent structure to the claimed “means for removably attaching the gun sight to a firearm” (since *Hasselbusch* uses one screw 3 in front and one screw 3 in back, this is not an equivalent structure to any of those shown and described in the present specification and drawings). Further regarding claim 22, the Final Office Action has failed to point out any equivalent structure in *Hasselbusch* where “the means for sighting the target further comprises a plurality of different-sized indicator means.” Accordingly, reconsideration of the rejection and allowance of these claims 19-22 are respectfully requested.

With regard to claim 26’s “means for compensating for a target motion by directing a horizontal component of aiming relatively further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target via a non-telescopic gun sight,” Applicant respectfully submits that *Hasselbusch* 937 lacks any structure “for compensating for a **target motion** by directing a horizontal component of aiming relatively

further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target,” but rather shows and describes a single open-top groove that can be adjusted to compensate for windage. Further, the Examiner has failed to point to any structures in *Hasselbusch* equivalent to the structures in the present application for performing the recited functions. Accordingly, reconsideration of the rejection and allowance of claim 26 are respectfully requested.

### *Claim Rejections – 35 USC § 102(b)*

Claims 19-22, and 26 were also rejected under 35 USC § 102(b) as being anticipated by *Jacobson* (United States Pat. No. **2,671,966**). Applicant respectfully traverses.

The Examiner points to elements 65, 73 (which form a **single** peep sight with a **single** variable-sized opening that can be micro adjusted for windage); however, this is not equivalent structure to any of the embodiments shown and described in the present invention, all of which compensate for target motion and all of which have a plurality of different-sized indicators. Claim 19, when properly examined as required by MPEP 2106, distinguishes over the *Jacobson* patent and appears in condition for allowance. No mention is made of using the invention disclosed in *Jacobson* for moving targets. Rather, the combination of the variables of windage and bullet drop still assumes a stationary target, albeit a stationary target at a great distance and with the projectile subjected to wind. Further regarding claim 20, the Final Office Action has failed to point out any equivalent structure to the claimed “means for removably attaching the gun sight to a firearm” (since *Jacobson* in Figure 5 shows a screw 7 pressing a ball 12 to tighten a dovetail slide 4/5, and Figure 13 uses one screw through hole 88 in front and one screw through hole 88 in back, neither of these are an equivalent structure to any of those shown and described in the present specification and drawings). Further regarding claim 22, the Final Office Action has failed to point out any equivalent structure in *Jacobson* where “the means for sighting the target further comprises a plurality of different-sized indicator means” since *Jacobson* is a single bore of variable size. Accordingly, reconsideration of the rejection and allowance of these claims 19-22 are respectfully requested.

With regard to claim 26's "means for compensating for a target motion by directing a horizontal component of aiming relatively further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target via a non-telescopic gun sight," Applicant respectfully submits that *Jacobson* 966 lacks any structure "for compensating for a **target motion** by directing a horizontal component of aiming relatively further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target," but rather shows and describes a single adjustable-size peep sight that can be adjusted side-to-side to compensate for windage. Further, the Examiner has failed to point to any structures in *Jacobson* equivalent to the structures in the present application for performing the recited functions. Accordingly, reconsideration of the rejection and allowance of claim 26 are respectfully requested.

#### *Claim Rejections – 35 USC § 102(b)*

Claims 19-22, and 26 were also rejected under 35 USC § 102(b) as being anticipated by *Finch* (United States Pat. No. **4,875,290**). Applicant respectfully traverses.

*Finch* describes a locking mechanism for a **windage adjustment knob** that allows the user to make gross and fine windage adjustments of the sighting aperture and then lock the aperture securely in place. The Examiner points to element 21 (which is a **single** archery sight with a **single** fixed-sized opening that can be adjusted side-side for **windage** compensation); however, this is not equivalent structure to any of the embodiments shown and described in the present invention, all of which compensate for **target motion** and all of which have a **plurality** of different-sized indicators. Claim 19, when properly examined as required by MPEP 2106, distinguishes over the *Finch* patent and appears in condition for allowance. No mention is made of using the invention disclosed in *Finch* for moving targets. Rather, the combination of the variables of windage and arrow drop still assumes a stationary target, albeit a stationary target at a great distance and with the projectile subjected to wind. *Finch*'s fine elevational adjustments can thereafter be made by selectively rotating the engaged worm gear or micrometer 11 to move the sight 1 vertically along the sight bar 5, which compensates only for arrow drop across distance.

Further regarding claim 20, the Final Office Action has failed to point out any equivalent structure to the claimed “means for removably attaching the gun sight to a firearm” (since *Finch* shows only attachment to an archery bow, and has no equivalent structures to those of the present invention. Further regarding claim 22, the Final Office Action has failed to point out any equivalent structure in *Finch* where “the means for sighting the target further comprises a plurality of different-sized indicator means” since *Finch* is a single bore of fixed size. Accordingly, reconsideration of the rejection and allowance of these claims 19-22 are respectfully requested.

With regard to claim 26’s “means for compensating for a target motion by directing a horizontal component of aiming relatively further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target via a non-telescopic gun sight,” Applicant respectfully submits that *Finch* lacks any structure “for compensating for a **target motion** by directing a horizontal component of aiming relatively further from an axis of the gunbarrel for a further target and relatively closer to the gunbarrel axis for a nearer target,” but rather shows and describes a single fixed-size peep sight that can be adjusted by knob rotation side-to-side to compensate for windage. Further, the Examiner has failed to point to any structures in *Finch* equivalent to the structures in the present application for performing the recited functions. Accordingly, reconsideration of the rejection and allowance of claim 26 are respectfully requested.

#### ***Allowable Subject Matter***

Claim 1-5, 10-17, 24, 25, and 27 have been allowed, and claim 23 would be allowed if placed into independent form. (See Office Action pg. 5, ¶ 7-10.) Applicant believes that given the arguments relative to the claim from which claim 23 depends, claim 23 was also now in allowable form; however, claim 23 has been amended to independent form to ensure its allowability.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((952) 278-3501) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 502931.

Respectfully submitted,

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